

REMARKS

I. Introduction

In response to the Office Action dated January 21, 2005, the claims have not been amended. Claims 1-57 remain in the application. Re-examination and re-consideration of the application is requested.

II. Prior Art Rejections

On page (2) of the Office Action, claims 1, 9, 20, 28, 39, and 47 were rejected under 35 U.S.C. §103(a) as being unpatentable over Landsman et al., U.S. Patent No. 6,314,451 (Landsman) in view of Eves et al., U.S. Patent No. 6,710,787 (Eves). On page (10) of the Office Action, claims 5, 24, and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over Landsman in view of Eves and further in view of O'Brien et al., U.S. Patent No. 6,055,569 (O'Brien). On page (11) of the Office Action, claims 6-7, 25-26, and 44-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Landsman in view of Eves and further in view of Borman et al., U.S. Patent No. 6,226,655 (Borman). On page (13) of the Office Action, claims 17-19, 36-38, and 55-57 were rejected under 35 U.S.C. §103(a) as being unpatentable over Landsman in view of Eves and further in view of Batchelder et al., U.S. Patent No. 6,351,767 (Batchelder).

Specifically, the independent claims were rejected as follows:

In regard to independent Claim 1 (and similarly independent Claims 9, 20, 28, 39, and 47), Landsman teaches embedding an "advertising tag" into a referring page. This tag contains two components. One component effectively downloads, from a distribution HTTP (web) server and to an extent necessary, and then persistently instantiates an agent, implemented as a "light-weight" Java applet, at the client browser (a first web page would have to be requested in this case, the first web page containing an applet tag). This agent then "politely" and transparently downloads advertising files (media and, where necessary, player files), originating from an ad management system residing on a third-party advertising HTTP (web) server, for a given advertisement into browser disk cache (also in the case of media files into the browser RAM cache) and subsequently plays those media files through the browser on an interstitial basis and in response to a user click-stream (Col. 9, line 67; Col. 10, lines 1-12; compare to Claim 1 (and similarly Claims 9, 20, 28, and 39), steps (a)-(e). It should be noted that the claimed steps (a)-(e) comprise a notoriously well-known method for downloading, instantiating, and executing a Java applet from a directive tag embedded in a web page.

Landsman fails to specifically teach (1) requesting one or more web objects that are likely to be accessed next as part of one or more additional web pages that are likely to be requested by a user. However, Eves teaches an access device (client) configured with a utility for pre-loading pages of data from the selected remote source, that is to say calling up pages and storing them rather than displaying them to the user on arrival. WebTV has this feature and uses it in combination with a predictor module to select pages to be downloaded, such that there is an improvement in the overall performance whenever the predictor has been correct and the user calls for a page which is already locally cached (Col. 3, lines 18-26). It should be noted that even though the utility and/or predictor

described by Eves does not offer how they are implemented, it would have been obvious to one of ordinary skill in the art at the time of invention to use Java applets as they will execute on multiple clients (browsers and machines) thereby providing the benefit of a "one code fits all" scenario. Eves also teaches that the particular value of this feature is that the particularly data-heavy area of graphics (*web objects*) in data pages (*web objects*) may be relieved to some extent by making use of this background pre-loading mechanism in combination with the particular arrangement of having, for a given group of pages to be downloaded, all the graphics for those pages together on a single dummy page which may be background downloaded to local storage in the users access device, without disturbing the viewing of initial pages (again pre-loading or pre-caching web objects). Hence, Eves's teaching follows the claimed steps (2)-(3). Eves's teaching also implies that one would be able to request additional pages, and assuming the predictor module was correct that that subsequent pages would be accessed from the cache and displayed. Compare with Claim 1 (and similarly Claims 9, 20, 28, and 39), steps (f)-(h). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Landsman and Eves as both inventions deal with methods for pre-caching web objects. The teaching of Eves adds the benefit of pre-caching web objects *non-interstitially*.

Applicants traverse the above rejections for one or more of the following reasons:

- (1) The combination of the cited references fails to teach the invention as claimed;
- (2) Improper hindsight is used to modify the teachings and combination of the prior art;

and

- (3) Landsman, Eves, O'Brien, Borman, and Batchelder fail to teach, disclose or suggest the use of a downloaded applet to request and precache objects likely to be accessed next as part of web pages likely to be requested by a user.

Independent claims 1, 9, 20, 28, 39, and 47 are generally directed to pre-caching information in a browser cache. Specifically, a client initially requests a first web page from a server. In response, the server sends back the first web page containing an applet. The applet is executed by the client and requests one or more web objects that are likely to be accessed next as part of additional web pages likely to be requested by the user. The web objects are sent by the server and cached in the browser cache on the client. The client then receives a request for a second web page from the user. In response to the request, the client retrieves the web objects from the cache (that are part of the second web page) and displays the retrieved web objects as part of the second web page.

Landsman merely describes a technique for implementing in a networked client-server environment, e.g., the Internet, network-distributed advertising in which advertisements are downloaded, from an advertising server to a browser executing at a client computer, in a manner transparent to a user situated at the browser, and subsequently displayed, by that browser on an

interstitial basis, in response to a click-stream generated by the user to move from one web page to the next. Specifically, an HTML advertising tag is embedded into a referring web page. This tag contains two components. One component effectively downloads, from a distribution web server and to an extent necessary, and then persistently instantiates an agent at the client browser. The other component is a reference, in terms of a web address, of the advertising management system. The ad management system selects the given advertisement that is to be downloaded, rather than having that selection or its content being embedded in the web content page. (See Abstract).

However, Landsman is specifically directed towards advertisements that are cached and played back on an interstitial basis (see col. 10, lines 10-12). Such a playback of advertisements is significantly distinguishable from and does not render obvious an applet that is configured to pre-cache web objects that are part of web pages that are requested by a user, followed by the display of such web objects as part of a web page specifically requested by the user. Landsman's advertisements are played on an interstitial basis. Accordingly to Landsman, interstitial ads are ads that are displayed in an interval of time that occurs after a user has clicked on a hot-link displayed by a browser to retrieve a desired web page but before that browser has started rendering that page. Such an interval, arises for the simple reason that a browser requires time, once a user clicks on a hotlink for a new page, to fetch a file(s) from a remote web server(s) for that particular page and then fully assemble and render that page (see col. 4, lines 43-52). Thus, instead of displaying a user selected web object that has been pre-cached (as claimed), Landsman merely provides for pre-caching an advertisement which is played while a selected web page is being transmitted to the client from the server.

The Office Action expressly admits that Landsman fails to teach the requesting of web objects that are likely to be accessed next as part of one or more additional web pages likely to be requested by a user. To reject this claim element, the Office Action relies on Eves.

Eves merely describes a network communications system comprising a plurality of user stations, each with respective processing and display capability. At least some of the stations are provided with a predictor mechanism which determines, for a given downloaded data page, the most likely next page, calls that data page up over the network, and downloads it to local cache storage whilst the user is still viewing the first page. To reduce some of the worst delays, due to graphic image downloads, one or more service provider host systems coupled via a data network such as the

Internet packages all the graphics data for a particular group of pages into a single dummy page which the user systems then background-download to cache. (See Abstract).

In rejecting the claims, the Office Action relies on Eves' description of a utility that is used to pre-load pages of data (see col. 3, lines 16-21). However, notoriously absent from Eves is any description whatsoever of how or what the utility is. In fact, the Office Action expressly states that "Eves does not offer how they are implemented". The claims of the present invention explicitly provide that an applet that is downloaded/received is configured to request web objects likely to be accessed next as part of one or more additional web pages that are likely to be requested by a user. In rejecting this claim element, the Office Action merely states that:

...it would have been obvious to one of ordinary skill in the art at the time of the invention to use Java applets as they will execute on multiple clients (browsers and machines) thereby providing the benefit of a "one code fits all" scenario.

Applicants respectfully disagree and traverse the above assertion. While the use of applets in general exist in the prior art, the present invention sets forth a specific use of an applet. Namely, the applet is configured to request web objects likely to be accessed next. None of the cited references even remotely describe such applet capability. The lack of any teaching or use of an applet in Eves merely allows Eves to fall within the previously cited prior art of O'Brien wherein a browser has software code incorporated within the browser. In this regard, O'Brien requires a modification of a browser (to incorporate the software code) (see col. 3, lines 28-34). As stated in the prior response, O'Brien teaches away from the use of an applet since the browser is modified with appropriate software code. Eves lack of any teaching regarding the "utility" that is used to pre-load pages does not affect or alter the state of the prior art. Eves does not suggest or allude to the use of an applet whatsoever.

The Office Action attempts to combine Landsman with Eves to teach all of the claim elements. Applicants submit that the combination completely fails to teach the invention as claimed. As stated above, Landsman teaches the use of an applet to provide for interstitial advertising and not for downloading web objects likely to be accessed next. In addition, Eves merely teaches the use of a utility to pre-load pages of data from a remote source. Accordingly, the combination of Landsman with Eves would merely provide for a browser with an applet used to retrieve interstitial ads and a utility or modified browser that is used to pre-load pages of data.

However, such a teaching is not what the current claims provide for. Again, the claims specifically provide for the use of an applet that is downloaded/received that is used to request web objects likely to be accessed next. Nothing in Landsman or Eves describes or suggests, explicitly or implicitly, an applet that is downloaded/received that is used to request web objects likely to be accessed next as requested by a user. Accordingly, the combination of Landsman and Eves fails to teach or render obvious the invention as claimed.

In addition to the above, Applicants also submit that impermissible hindsight has been used to combine Landsman with Eves to teach the present claims. MPEP §706.02(j) provides that “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” Further, under MPEP §2141.01, “The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention”. It is not Appellants obligation to disprove that a reference has or does not have any characteristics that would prevent it from being combined with another reference. Instead, under MPEP 2143, it is the Examiner’s obligation to set forth a prima facie case of obviousness. As part of establishing the case, the Examiner must meet three criteria: he must show that some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants’ disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In view of the above, Applicants submit that there is no motivation to produce the claimed invention by combining Landsman with Eves. Firstly, neither reference even remotely suggests the use of an applet to retrieve content likely to be accessed next as part of web pages likely to be requested by a user. In this regard, there is no motivation to use Landsman’s interstitial advertising applet in the context of Eves’ utility for pre-loading data. The Office Action has completely failed to provide any such motivation in either Landsman or Eves. The Office Action offers the motivation of providing the benefit of a “one code fits all” scenario. However, an electronic search of Eves for the term “code” or “one code” provides no results whatsoever. In addition, an

electronic search of Landsman for the terms "code fits" provides no results either. Without either reference mentioning the Office Action's quoted language of "one code fits all", the offered benefit is not suggested or provided by the references.

Again, the claims provide a specific use of an applet relating to the request of web objects likely to be accessed next. To state that Landsman's interstitial advertising applet (that is completely irrelevant and not utilized in the context of web objects likely to be requested) to retrieve/pre-load web pages in Eves relies on hindsight offered by the teaching of the present invention. In this regard, only with the teaching of the present invention, would there be a suggestion to combine the references or any expectation of success.

Moreover, the various elements of Applicants' claimed invention together provide operational advantages over Landsman, Eves, O'Brien, Borman, and Batchelder. In addition, Applicants' invention solves problems not recognized by Landsman, Eves, O'Brien, Borman, and Batchelder.

Thus, Applicants submit that independent claims 1, 9, 20, 28, 39, and 47 are allowable over Landsman, Eves, O'Brien, Borman, and Batchelder. Further, dependent claims 2-8, 10-19, 21-27, 29-38, 40-46, and 48-57 are submitted to be allowable over Landsman, Eves, O'Brien, Borman, and Batchelder in the same manner, because they are dependent on independent claims 1, 9, 20, 28, 39, and 47, respectively, and thus contain all the limitations of the independent claims. In addition, dependent claims 2-8, 10-19, 21-27, 29-38, 40-46, and 48-57 recite additional novel elements not shown by Landsman, Eves, O'Brien, Borman, and Batchelder.

III. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

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